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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/062,409	02/05/2002	Peter J. Wilk	7883.0003-04	6182
22852	7590	11/29/2005		
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			EXAMINER IMAM, ALI M	
			ART UNIT	PAPER NUMBER
			3737	

DATE MAILED: 11/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/062,409

Applicant(s)

WILK, PETER J.

Examiner

Ali Imam

Art Unit

3737

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02/5/02 (Pre-Amendment).
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18-49 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18-49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>5/31/2</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of the Claims

1. Currently, claims 18-49 are pending.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 1-26 and 28-40 are rejected under 35 U.S.C. 102(e) as being anticipated by Ben-Haim (US 5,738,096).

In regard to claims 1-26, 28, and 29, Ben-Haim teaches in Fig. 6, an apparatus for measuring a thickness of a heart wall comprising a member/catheter (72) having a distal end (74) configured to be positioned adjacent a heart wall (see Fig. 6), and an ultrasound indicator/transducer (col. 20, lines 51-63) sildably disposed in a lumen proximate a distal end of the catheter (72) in order to measure a thickness of the heart wall. Ultrasound transducer

inherently includes first elements for transmitting a pressure wave and second elements for sensing a reflected pressure wave. Furthermore, Ben-Haim's apparatus for measuring a thickness of a heart wall would inherently include an analyzer for determining the thickness of the heart wall. Ben-Haim further teaches a sensing mechanism (73) for determining a displacement of a tip of the device into the heart wall (see also, col. 18, lines 3-19) and a laser (col. 21, line 14) for penetrating the heart wall.

In regard to claims 30-40, Ben-Haim teaches all the structures as set forth above. The method concerning the steps of providing a member having a distal end and an indicator, positioning the distal end adjacent to the heart wall, using the indicator to measure the thickness of the heart wall, etc., are inherently met by the disclosure.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 27 and 41-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ben-Haim (US 5,738,096) in view of Payne et al. (US 5,728,091). Ben-Haim teaches all the limitations of the claimed subject matter except for mentioning specifically the step or structure of lasing or drilling to form a recess/channel in the heart wall. Payne teaches a method of lasing or drilling to form a recess/channel in the heart wall (col. 1, lines 44-46). Payne further teaches that the newly formed channels are used to increase blood flow to the heart tissue experiencing ischemic conditions. Ben-Haim acknowledges that a chronic ischemic condition is usually caused


by blockage of the coronary arteries. Therefore, it would have been obvious to an ordinary skill in the art, at the time the invention was made to use Payne's step or structure of lasing or drilling a channel in the heart wall in using the method and apparatus of Ben-Haim in order to increase blood flow to the coronary arteries of the heart so that chronic ischemic condition is reduced.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ali Imam whose telephone number is 571-272-4737. The examiner can normally be reached on Mon. - Th., 8:00- 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Casler can be reached on 571-272-4956. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Ali Imam
Primary Examiner
Art Unit 3737